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10/585,184	06/30/2006	Una Tucker	2001855.00120 US1	1165
23483	7590	04/07/2010	EXAMINER	
WILMERHALE/BOSTON			MATTER, KRISTEN CLARETTE	
60 STATE STREET			ART UNIT	PAPER NUMBER
BOSTON, MA 02109			3771	
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			04/07/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/585,184	Applicant(s) TUCKER, UNA	
	Examiner KRISTEN C. MATTER	Art Unit 3771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 12-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/30/06 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/2/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group I (claims 1-11) in the reply filed on 2/18/2010 is acknowledged.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the United Kingdom on 12/30/2003. It is noted, however, that applicant has not filed a certified copy of the 0330185.0 application as required by 35 U.S.C. 119(b).

Examiner notes that certified copies of application numbers 0406612.2, 0406613.0, 0406614.8, and 040264634, all filed in the United Kingdom, have been received and placed of record in the file.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the heating device must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure

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must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 8 is objected to because of the following informalities: in line 2, "sard" should change to --said-- to correct the typographical mistake. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 10, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 3 and 7, use of the terms "such rings," "the rings" and "such finger rings" is confusing because the claim doesn't require rings in the prior art to read on the device, since the rings can be "notches" instead of "rings" as currently claimed. In addition, the claim

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refers to a “bottommost portion” that then also appears to be the “upper surface” of the rings, making use of the orientation terms confusing (i.e., what is considered up, down, top, bottom??). Also, in line 6, “and further comprising” is confusing because it is unclear if the bottommost part of the device contains the dome member or if the device itself must have an arched dome member located anywhere to read on the claim. Examiner suggests better defining the orientation of the device before using terms such as top, bottom, side, upper, lower, etc.

Claims 2-4, 10, and 11 recite the limitation “the upper part” in lines 1 and/or 2. There is insufficient antecedent basis for this limitation in the claims.

Claim 6, in line 2, claims that the handgrip is concave. However, the handgrip was claimed as being convex in claim 1, line 6, making it confusing as to what the shape of the handgrip actually is.

Claim 5 is dependent on claim 1 and is therefore rejected for the same reasons outlined above with respect to claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by York (US 6,241,696).

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Regarding claim 1, York discloses a hand-held self-contained massaging device comprising a lower portion (3) which is a hand grip (see abstract) comprising a plurality of finger rings or notches (5) arranged consecutively and connected to each other and are of a dimension to accommodate the fingers of one hand (see Figure 7), wherein the bottommost portion of the massaging device or handgrip is of a convex nature (i.e., both the extreme top and bottom edge seen in Figure 2 has a portion that can be considered convex) and further comprising an arched dome member (2 or 10) connected to the upper surface of the rings (see Figure 2), the arch dome member being of a size suitable for effective general effleurage and lymph drainage and effleurage on a user's limbs (i.e., see Figure 7; the device is the same general size as the instant invention and thus inherently sized to perform the same function).

Regarding claim 2, the upper part is gently tapered at each end of the arched dome member and thus suitable for focused petrissage and friction massage movements (see Figure 7; either the general curve of the arch member itself or the ends near reference character 1 can be considered the gentle taper).

Regarding claim 6, as seen in Figure 2, the inside of the handgrip is concave.

Regarding claim 7, York discloses a hand-held self-contained massaging device comprising an uppermost portion (i.e., everything except the surface that touches a user's hand in Figure 7; there is nothing structurally limiting the uppermost portion to any specific part of the device and thus the "portion" can be arbitrarily defined) having a solid arched dome (2), a plurality of finger holes or notches (5) arranged consecutively and connected to each other and are of a dimension to comfortably accommodate the fingers a user's hand (see Figure 7), wherein the device further comprises an outer finger notch on the side of the uppermost portion (see

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Figure 7, where user's thumb is seen as resting or at the base of the dome member near reference character 1, either can be considered a finger notch), wherein the uppermost portion further comprises gently tapered edges capable of focused petrissage (see Figure 7; either the general curve of the arch member itself or the ends near reference character 1 can be considered the gentle taper), wherein said device additionally comprises a plurality of teeth (10) of a size and dimension to enable free-flowing, no-tangle movement when stroking, waving, or using compression movements on the scalp of a patient.

Regarding claim 8, claim 8 merely recites intended use of the device. Since York is fully capable of being held in any manner desired by a user, the device is inherently capable of being inverted to use the teeth (10) as a grip and using the opposite end for massage.

Regarding claim 9, the teeth have rounded tips (see Figure 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over York as applied to claims 1 and 7 above, and further in view of Dehli (US 6,786,878). York lacks an upper part filled with air. However, Dehli discloses a hand-held massages with a hollow grip and massage portion (since it is not clear which must be considered the "upper part") that is hollow and filled with air (see abstract). Therefore, it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to have modified York's device to include a hollow device filled with air as taught by Dehli since it would have provided a means to enhance the massage by combining compression with warm air. Furthermore, there is nothing structurally that would prevent the addition of a fan/warm air in the device of York and it appears as though the device would perform equally well being filled with air (either thrown the balls themselves or around it as taught by Dehli).

Claims 3-5, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over York as applied to claims 1 and 7 above, and further in view of Baer (US 2005/0049526).

Regarding claims 4, 5, and 11, York lacks the handgrip or upper part being hollow and filled with an inert liquid or heating device. However, Baer discloses a hand-held massager that is hollow and filled with an inert fluid (20). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified York's device to include a hollow device filled with fluid as taught by Baer since it would have provided a means to enhance the massage by combining compression with temperature changes as desired (i.e., from the warm or cool fluid). Furthermore, there is nothing structurally that would prevent the addition of a fluid in the device of York and it appears as though the device would perform equally well being filled with fluid. What fluid the device is filled with is considered an obvious design consideration to one of ordinary skill in the art (i.e., Baer discloses that the fluid can be removed and changed as desired; see paragraph 30).

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Regarding claims 3 and 10, it is also considered an obvious design consideration to one of ordinary skill in the art that the “fluid” of Baer be air.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Diamond is cited to show another massager that uses heated fluid to enhance the massage.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTEN C. MATTER whose telephone number is (571)272-5270. The examiner can normally be reached on Monday - Friday 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kristen C. Matter/

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